

REMARKS

This is in response to the Office Action dated March 21, 2006. Claims 1-22 and 27-28 are pending. *Note that this amendment after final should be entered because the only change to the claims is a correction of a minor typographical error in claim 12, that does not affect the scope of the claims.*

Applicant notes with appreciation the Examiner's indication that claims 4-6, 15-17 and 28 contain allowable subject matter.

It is noted that the Examiner has requested that in section 3 of the Office Action, it appears as if the Examiner is indicating that JP 04-293782 should be submitted in paper form on a PTO-1449. This has been done herewith. In particular, JP 04-293782 has now been filed in connection with a PTO-1449 herewith for consideration by the Examiner. See pg. 4 of the instant specification, which discussed this reference.

Claim 1

Claim 1 stands rejected under Section 102(b) as being allegedly anticipated by DE 3336652 (DE '652). This Section 102(b) rejection is respectfully traversed for at least the following reasons.

Claim 1 requires "a substrate holder disposed between the anode electrode and the cathode electrode; and one conductive member disposed between the substrate holder and one electrode of either the anode electrode or the cathode electrode, wherein the substrate holder supports the substrate, the one conductive member is provided between the one electrode and the substrate holder so as to substantially cover an entire space between the one electrode and the substrate holder, and the one conductive member is electrically connected to the one electrode and the substrate holder." Thus, claim 1 requires a substrate holder that supports the substrate,

and requires that the conductive member is electrically connected to at least the electrode and the substrate holder. For purposes of example and without limitation, the substrate holder is advantageous in that it permits suppression or reduction of unnecessary discharge occurring in a gap between a substrate holder and an electrode, and may suppress or reduce formation of an uneven discharge on a substrate. The cited art fails to disclose or suggest the aforesaid underlined features of claim 1.

DE '652 fails to disclose or suggest a substrate holder that supports the substrate, and also fails to disclose or suggest that the at least one conductive member is electrically connected to the one electrode and the substrate holder as required by claim 1. In particular, element 19 of DE '652 is a substrate, *not* a substrate holder. Moreover, element 23 in DE '652 is merely a carbon layer, and is not a substrate. Thus, it will be appreciated that DE '652 fails to disclose or suggest the claimed substrate holder, and also fails to disclose or suggest a conductive member electrically connected to the one electrode and the substrate holder as required by claim 1. DE '652 is entirely unrelated to claim 1 in these respects.

DE '652 discloses a device for depositing hard carbon layers by way of RF plasma deposition. The electrode 5 is covered with a quartz cover 22, and supports the substrate 19 which is to be coated. Additionally, DE '652 discloses that in order to produce a connection in DC terms to the top side of the electrode 5, the central region 26 of the quartz cover 22 is produced from an electrically conductive carbon modification (see English Abstract of DE '652). In contrast, claim 1 recites that *the conductive member is provided between the one electrode and the substrate holder so as to substantially cover an entire space between the one electrode and the substrate holder*. In particular, although one may argue that in DE '652 a central region 26 of the quartz cover 22 is produced from an electrically conductive carbon modification, DE '652

clearly fails to disclose or suggest that the central region 26 is “provided between the one electrode and the substrate holder so as to . . . “ as required by claim 1.

The Office Action appears to contend that substrate 19 in DE ‘652 is analogous to the substrate holder of claim 1, and as a result the reference discloses that the central region 26 (alleged electrically conductive carbon modification) is provided between the electrode 5 and the alleged holder 19. However, this contention is improper and inconsistent with the disclosure of DE ‘652 and the instant application for at least the following reasons.

First, as explained in MPEP Section 2106, the broadest reasonable interpretation of the claims must be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 49 USPQ2d 1464 (Fed. Cir. 1999). The Office Action fails to do this in this case. First, DE ‘652 clearly and explicitly discloses that the element 19 is a “substrate” – not a substrate holder. Thus, it is clear that one of skill in the art would understand element 19 of DE ‘652 to be a substrate, *not* a substrate holder as alleged in the Office Action. This is consistent with both the cited art and the instant application. Indeed, DE ‘652 already discloses that the electrode 5 is covered with a quartz cover 22 which *supports* the substrate 19 (see English Abstract of DE ‘652). Moreover, as disclosed in DE ‘652, element 23 is a carbon layer, not a “substrate” as alleged in the Office Action. One of ordinary skill in the art would never interpret the claimed “substrate” to read on a mere carbon layer as alleged in the Office Action. Indeed, DE ‘652 even states that the carbon layer 23 is deposited onto the substrate 19 which is directly contrary to the stretched contention set forth in the Office Action (see English Abstract of DE ‘652).

Second, claim 1 requires “*forming a thin film on a substrate* by performing plasma discharge between” While the applicant disagrees with the Examiner that element 19 is a

holder, even if it were arguably said to be a substrate holder 19 with carbon layer 23 as a substrate thereon as incorrectly alleged in the Office Action, this would still be inconsistent with the disclosure of DE '652 and still would not result in the invention of claim 1. DE '652 only discloses the deposition of carbon layer 23 onto the substrate 19, and does *not* disclose deposition of any additional layers on the carbon layer 23. Accordingly, even if the substrate 19 were improperly found to be a holder and the carbon layer 23 a substrate as alleged in the Office Action, DE '652 would still fails to disclose or suggest forming a thin film on the substrate because DE '652 does not disclose forming any further additional layer(s) on the carbon layer 23. Thus, even the alleged incorrect construction set forth in the Office Action fails to meet the invention of claim 1 in this regard.

The art rejection of claim 1 should be withdrawn for at least the reasons set forth above.

Claim 12

Claim 12 requires “a substrate holder disposed between the anode electrode and the cathode electrode; and a plurality of conductive members disposed between the substrate holder and one electrode of either the anode electrode or the cathode electrode, wherein the substrate holder supports the substrate, the plurality of conductive members are provided in parallel to each other between the one electrode and the and the substrate holder so as to cover a substantially entire space between the one electrode and the and the substrate holder, and the plurality of conductive members are electrically connected to the one electrode and the substrate holder.” DE '652 fails to disclose or suggest these underlined features of claim 12. DE '652 fails to disclose or suggest the claimed substrate holder, and also fails to disclose or suggest conductive members electrically connected to the one electrode and the substrate holder as

required by claim 12. DE '652 is entirely unrelated to the invention of claim 12 in these respects.

With respect to claim 12, the Office Action admits that DE '652 does not expressly teach a "plurality of conductive members are provided in parallel to each other . . ." However, the Office Action contends that this would have been obvious because DE '652 discloses motivation for doing so to allow damaged or overly coated sections to be replaced without necessitating replacement of the entire conductive piece. However, DE '652 does *not* disclose or suggest a "*plurality of conductive members are provided in parallel to each other . . .*" as recited in claim 1, and also does not disclose or suggest any motivation for this feature. The entire English Abstract of DE '652 fails to disclose or suggest replacing any damaged or overly coated sections without necessitating replacement of the entire conductive piece. Therefore, according to MPEP Section 706.02(j), the Examiner has failed to establish a *prima facie* case of obviousness, as there is not suggestion or motivation in the cited art for the alleged modification. Hindsight is not permitted, and the Section 103(a) rejection of claim 12 is fundamentally flawed in this respect.

Claim 27 requires that "the conductive member comprises a plurality of spaced apart conductive members that are in electrical communication with each other." DE '652 fails to disclose or suggest these features of claim 27.

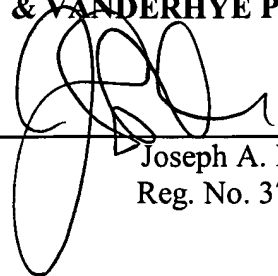
It is respectfully requested that all rejections be withdrawn. All claims are in condition for allowance. If any minor matter remains to be resolved, the Examiner is invited to telephone the undersigned with regard to the same.

SHIMIZU et al
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Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____

A handwritten signature in black ink, appearing to be 'JAR', written over a horizontal line.

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